

## **REMARKS**

### **Amendments to the Specification**

Reference to the claims in the specification is removed.

The compounds from original claim 2 are now recited in the specification on page 26.

This is not new matter since the material appeared in an original claim.

### **Amendments to the Claims**

Support for the amendments to the definitions of  $R^2$  and  $R^3$  in claim 4, and for new claim 15, can be found, for example, on page 17, lines 29 and 30.

Claim 1 is rewritten as a dependent claim from claim 4.

Support for new claims 16-30 can be found, for example, on page 18, lines 12 to page 26, line 17. More specifically:

- claims 16 to 21 correspond to embodiments Ia to Ii,
- claim 22 is a new independent claim corresponding to original independent claim 4 amended in view of the disclosure on page 18, lines 12-13,
- claim 23 corresponds to now dependent claim 1, amended in view of the disclosure on page 18, lines 12-13,
- claims 24 to 28 correspond to embodiments Ib to If,
- claim 29 corresponds to embodiment Iv, and
- claim 30 corresponds to embodiment Ii.

Claim 51 is a new independent claim corresponding to original independent claim 4 amended in view of the disclosure on page 13, lines 19-16. Claim 52 is dependent therefrom. Claims 51 and 52 are proper under *In re Johnson*, 194 USPQ 187 (CCPA 1977). Claim 53 corresponds to now dependent claim 1, amended in view of the disclosure on page 13, lines 19-16.

Additional method, process and product claims dependent on the compound claims are also added.

### **Claim Rejections Under 35 USC § 112 and Under 35 USC § 101**

The rejections are moot in view of the amendments.

The term "solid phase" has been removed from the definition of  $R^2$  and  $R^3$  in compound claims, but is retained in process of preparing claims. Support for this can be

found, for example, on page 30, lines 25-27, and also in example 2 on page 41. Claims 61-64 are directed to intermediates having the solid phase.

### **Claim Rejections Under 35 USC § 102**

The rejections are moot in view of the amendments.

With respect to new independent claim 51 and its dependent claims, applicants have the following comments with respect to US 5,783,577.

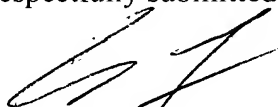
The court in *In re Sivaramakrishnan*, 673 F.2d 1383, 213 USPQ 441 (CCPA 1982), recognized that “in cases involving an overlap of a claimed invention and applied prior art, anticipation under 35 U.S.C. 102 depends upon the extent of overlap which determines the amount of picking and choosing necessary to arrive at the claimed invention.” The amount of picking and choosing in the present case is large. One of ordinary skill in the art without guidance would not be motivated to pick groups in the general formulae of the reference such that a compound of the claimed invention would be achieved, especially in view of the teachings away from such selections.

‘577 teaches a generic formula II in which R<sup>1</sup>, R<sup>2</sup> and Y are taught to have meanings as provided “previously.” Y is broadly defined “previously” in the reference and contains species that may overlap the claimed compounds. See specification on column 2, lines 62 to 65. However, in embodiments of formula II, even if everything else met the features of the present claims, which is not admitted to be the case, the reference only teaches that Y is “present or absent and, if present, is carboxylic acid, carboxamide, protected carboxamide, an amino resin, or a hydroxy resin,” none of which options for Y anticipate or render obvious the claimed invention. See column 5, lines 36-38. In an additional embodiment for the compounds of formula II, Y is once again defined as “present or absent and, if present, is carboxylic acid, carboxamide, protected carboxamide, an amino resin, or a hydroxy resin.” See column 7, lines 7-10. Without any specific guidance to the selection of a Y group in the reference which would overlap the generic formula of claim 51 and its dependent claims, said claim is not anticipated or even rendered obvious. See *In re Baird*, 16 F.3d 380, 29 USPQ2d 1550 (Fed. Cir. 1994). A mere broad disclosure that generally encompasses millions of compounds, does not anticipate subject matter that may fall within the scope of said disclosure absent some teaching or suggestion toward the selection of such subject matter. One of ordinary skill in the art, absent some teaching or suggestion would not be motivated to

pick groups in the general formulae of the reference that would render the claimed invention unpatentable.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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Filed: January 29, 2004

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